

APR 17 2006

67,108-133
Kim 13-4

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application: Kim, et al.
Serial No.: 10/037,051
Filed: 11/07/2001
Group Art Unit: 2634
Examiner: Wong, Linda
For: PEAK LIMITING ARCHITECTURE AND METHOD

REQUEST FOR RECONSIDERATION

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This paper is responsive to the Office Action mailed on January 20, 2006. Applicant respectfully requests reconsideration.

Applicant appreciates the fact that the Examiner made the most recent office action non-final. For the reasons stated below, Applicant respectfully submits that this case is in condition for allowance.

The rejection of claims 2-9, 16-20 under 35 U.S.C. §103 based upon the proposed combination of *Wheatley* and *Hahm* does not establish a *prima facie* case of obviousness. A proposed combination of references cannot be made when the proposed modification to the primary reference (i.e., *Wheatley*) involves removing or defeating an intended feature or function of that reference. In this case, the proposed substitution of *Hahm's* technique for the multiplying technique in *Wheatley* cannot be done because it entirely

67,108-133
Kim 13-4

removes the functionality disclosed in the *Wheatley* reference. That is not a permissible modification of a reference under 35 U.S.C. §103. There is no *prima facie* case of obviousness because there is no motivation for making such a modification to the teachings of *Wheatley* and the combination of *Wheatley* and *Hahm* cannot be made.

The rejection of claims 12-14 under 35 U.S.C. §103 based upon the proposed combination of *Wheatley* and *Orban* does not include a *prima facie* case of obviousness. There is no motivation for making the proposed combination, in part, because *Orban*'s clipping filter does not have any usefulness in connection with the techniques described in the *Wheatley* reference. The Examiner has not explained, for example, how *Orban*'s clipping filters would fit within the *Wheatley* arrangement. Additionally, the *Wheatley* reference already includes a filter so that the addition of *Orban*'s filter would be redundant, at best. There is also no suggestion or motivation for substituting *Orban*'s filter for the filter already taught by *Wheatley*. The combination of *Wheatley* and *Orban* cannot be made.

The rejection of claims 10-11 under 35 U.S.C. §103 based upon the proposed combination of *Wheatley*, *Orban* and *Birchler* does not include a *prima facie* case of obviousness. As discussed above, *Wheatley* and *Orban* cannot be combined as proposed by the Examiner. The proposed addition of the teachings of *Birchler* does not remedy the defect in the base combination. There is no *prima facie* case of obviousness.

The rejection of claims 21-24 under 35 U.S.C. §103 based upon the proposed combination of *Wheatley*, *Hahm* and *Birchler* does not include a *prima facie* case of obviousness. As discussed above, *Wheatley* and *Hahm* cannot be combined. The

67,108-133
Kim 13-4

proposed additional of *Birchler* does not remedy the defects in the base combination and there is no *prima facie* case of obviousness.

Applicant has explained why the combinations proposed by the Examiner cannot be made and there is no *prima facie* case of obviousness. None of Applicant's claims can be considered obvious.

This case is in condition for allowance. If the Examiner believes that a telephone conference will facilitate moving this case forward toward being issued, Applicant's representative will be happy to discuss any issues regarding this application and can be contacted at the telephone number indicated below.

Respectfully submitted,

CARLSON, GASKEY & OLDS

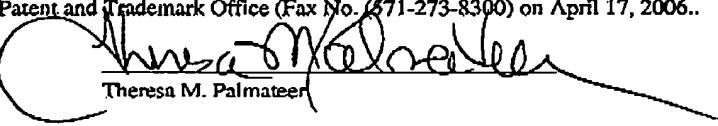
By: 

David J. Gaskey
Registration No. 37,139
400 W. Maple Rd., Ste. 350
Birmingham, MI 48009
(248) 988-8360

Dated: April 17, 2006

CERTIFICATE OF FACSIMILE

I hereby certify that this Request for Reconsideration relative to Application Serial No. 10/037,051, is being facsimile transmitted to the Patent and Trademark Office (Fax No. 571-273-8300) on April 17, 2006..


Theresa M. Palmateer

N:\Clients\LUCENT TECHNOLOGIES\IP00133\PATENT\Request for Reconsideration 4-06.doc